

REMARKS

Claims 1-44 are pending in the application. No claims are amended herein.

Applicant respectfully submits that all of the claims are allowable over the prior art of record in this application and Applicant respectfully requests the Examiner to withdraw the rejections of all of these claims and to allow all of them.

Applicant's Invention

Applicant's invention relates to a process for removing a source-derived contaminant from a hydrocarbon-containing material, in which the hydrocarbon-containing material is, e.g., recycled petroleum product, such as recycled engine oil, or the product of a pyrolytic plastics recycling operation. In the past and in the prior art, such recycled materials have been found to be contaminated to a point which rendered them undesirable for many uses to which virgin, refined petroleum-source hydrocarbons are generally put. The contaminations included, for example, undesirable odor and color. The Applicant operates a used-petroleum product recycling plant and has developed the present invention in an effort to obtain a product that is more widely useable than prior art recycled petroleum products. The presently claimed invention allows the Applicant to remove such contamination in an efficient, cost-effective way.

Rejection of Claims over Garrett in view of Bullock.

In the Office Action dated 24 May 2007 all of the pending claims were rejected as obvious over the basic combination of Garrett and Bullock, and in some cases, Ciora or Johnson. Applicant traverses the rejections of the claims over Garrett and Bullock, with or without Ciora or Johnson, for at least the following reasons.

1. Claims 1-24:

Garrett discloses a process for treating transformer oil with Fuller's earth. The Garrett process includes and requires further processing subsequent to the treatment with Fuller's earth, including dewatering and degassing the product, in order to obtain

re-useable transformer oil. Applicant's process requires no such further processing, as defined in the presently pending claims 1-24.

Bullock discloses only the breakdown of various materials into a material that, as contended by the Examiner, might be used as a feedstock for Garrett's process. Bullock does not contain any disclosure or suggestion that if its product is fed to a process such as that of Garrett, part of the process could be omitted.

Therefore, the contended combination of these references fails to disclose all the limitations of Applicant's claims 1-24. To wit, these references fail to disclose the claimed limitation that the process does not include additional or separate steps to remove any contaminant after the contacting step.

In response to Applicant's amendment and arguments, the Examiner attempted to avoid this limitation by the inappropriate and inapt contention:

In addition, the omission of an element and its function is not [sic] obvious if the function of the element is not desired (see MPEP 2144.04 II A). Therefore, the limitation that the process does not include additional steps would be prima facie obvious.

Applicant presumes that the Examiner mistakenly included the "not" to which Applicant has appended "[sic]" in the above quoted statement, since otherwise, the Examiner has admitted and acknowledged that elimination of the step would not have been obvious. This statement, assuming the "not" was actually erroneously included, flies in the face of Garrett's clear requirement of further processing after the clay filtration to obtain an acceptable product. Garrett explicitly and without qualification requires the functions provided by the chilling, centrifugation, and second stage heating elements, to remove water and gas in order to obtain a suitable product. In fact, Garrett does not even show a point at which the intermediate material could be removed from the process flow prior to the product removal 13. Garrett's description of the process contains no hint or suggestion that any of these steps could be omitted. Garrett's description of the

process and the product contains no hint that any sort of acceptable product could be obtained in the absence of these "post-clay" steps.

Regarding the MPEP citation, the Examiner should have read a bit further. Had the Examiner read the next entry, MPEP 2144.04 II B, wherein it is stated "omission of an element with retention of the element's function is an indicia of unobviousness", the Examiner would have found a much more appropriate and apt view of the presently claimed invention. In the present case, the product obtained has removed the source-derived contaminant in the clay contacting step to a sufficient extent that no further treatment is needed and, most importantly, to an extent at which any further treatment steps to remove any contaminant can be excluded. Thus, in the present case, an element has not only been omitted but has been expressly excluded, and the function of the omitted and excluded element has been retained. This is a clear showing of unobviousness, as compared to the contended combination of Garrett and Bullock, which combination expressly and without qualification requires the "post-clay" portion of the Garrett process. There is simply no basis for omitting or excluding this portion of the Garrett process. The Garrett process requires these steps as a integral part thereof. There is not even a hint in Garrett either that the process could be stopped early or that any sort of acceptable product could be attained without the functions provided by the chilling, centrifugation, and second stage heating elements, to remove water and gas from the raw product.

The "post-clay" processing steps of Garrett are an integral part of the process disclosed and necessary to obtain the disclosed product. If one were to modify the teachings of Garrett, the process disclosed by Garrett would be rendered inoperable for the purpose taught by the reference. See, *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose). If a proposed modification would so change the process of the prior art, then the modification cannot be considered to have been obvious. For this additional reason, the

claimed invention would not have been obvious over the contended combination of Garrett and Bullock.

With respect to the presently pending dependent claims, these claims further distinguish over Garrett. In particular, there is no way that early termination of the Garrett process, before the latter steps including the functions provided by the chilling, centrifugation, and second stage heating elements, to remove water and gas, could result in the formation of a refinery grade hydrocarbon, as specified in, e.g., claim 4, or a hydrocarbon suitable for use in a motor vehicle, as in claim 25.

Accordingly, Applicant respectfully submits that Garrett and Bullock cannot have rendered obvious any of the pending claims 1-24, in any of the asserted combinations, with or without the tertiary references. For this reason, Applicant respectfully submits that the presently pending claims 1-24 fully distinguish over the prior art and are in condition for allowance.

2. Claims 25-44:

With respect to claims 25-44, the combination of references fail to disclose all the limitations of these claims. The foregoing arguments and facts set forth with respect to the combination of Garrett and Bullock applies with at least equal force to claims 25-44, and are incorporated herein by reference, and applied to claims 25-44.

While the Examiner admitted that the disclosure of Garrett does not disclose blending the product with another hydrocarbon, the Examiner failed to identify any disclosure in any of the other cited references to remedy this shortcoming. Thus, the Office Action failed on its face to state a *prima facie* case of obviousness with respect to claims 25-44, since it has failed to identify in the prior art all of the limitations of the rejected claims.

Applicants are not aware of any teaching in any of the references to blend the products as claimed and, as noted, the Examiner has not cited any such disclosure.

Accordingly, Applicant respectfully submits that Garrett and Bullock, with or without Ciora or Johnson, cannot have rendered obvious any of the pending claims 25-

44, in any of the asserted combinations. For this reason, Applicant respectfully submits that the presently pending claims 25-44 fully distinguish over the prior art and are in condition for allowance.

CONCLUSION

As shown by the foregoing, Applicants respectfully submit that the presently disclosed and claimed invention patentably distinguishes over the asserted prior art. Accordingly, Applicants request the Examiner to withdraw the previously stated rejections and to allow the present claims.

If any issues remain, or if the Examiner considers that a telephone interview would be helpful to facilitate favorable prosecution of this application, the Examiner is invited to telephone the undersigned attorney.

It is believed no additional fee is required for this filing. However, if any additional fee is required, please charge the fee to Deposit Account No. 18-0988, Order No. ORRCP0100US.

Respectfully submitted,

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